

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Batoff, Jeffrey**

Serial No.: **10/085,394**

Group Art Unit: **3627**

Filed: **February 28, 2002**

Examiner: **Zeender, Florian M.**

For: **INVENTORY CONTROL AND BALANCING SYSTEM**

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**ELECTION OF SPECIES WITH TRAVERSE**

In response to the Election of Species Requirement dated September 6, 2006, Applicant elects with traverse Group (I), which was identified in the Election of Species Requirement as including Claims 63, 69, 87-90, 110, 112-113, 115-116, 118-120, 188-223 and 212-223.

Applicant respectfully traverses the Election of Species Requirement and requests that it be withdrawn. The Office Action argues that the following features render the “species” distinct:

Species I: “barter system requests or determines when another user surrenders a desired item”

(See Specification pg. 31, lines 9-13; pg. 37, lines 13-19; pg. 38, lines 1-5)

Species II: “only items listed in one or more lookup databases may be entered”

(See Specification pg. 46, lines 3; pg. 50, lines 18-21)

Species III: “the barter system estimates the cost of postage”

(See Specification pg. 31, lines 8-11)

Species IV: “the system monitors user compliance with a consumer user obligation”

(See Specification pg. 16, lines 14-20; pg. 35, lines 8-13; pg. 45, lines 4-11)

These features, however, are disclosed in the specification as part of a single embodiment (See citations). The specification does not state that the features that were identified in the Office Action belong to separate embodiments. In addition, the claims claim these features in combination with each other. Independent claim 253 in particular is directed a combination of these four features. Obviously, then, the four features are not mutually exclusive as MPEP 806.04(f) requires:

**806.04(f) Restriction Between Mutually Exclusive Species [R-3]**

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.

In fact, the four features are part of a single preferred embodiment, and the claims within the various groups that were identified in the Office Action severally overlap in scope with each other. Accordingly, as the MPEP points out, these four features can not in fact be separate and distinct species of the invention.

Restriction between the identified groups would not be proper, either. MPEP 806.03 states:

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition. MPEP 806.03.

In addition, for a Restriction Requirement or an Election of Species Requirement to be appropriate, examination of the alleged distinct inventions must impose a serious administrative burden on the examiner. See MPEP 803 and 808. To establish undue burden, the alleged distinct inventions must be: directed to separate classifications, directed to divergent subject matter or

require a different field of search. MPEP 808.02 further requires that the examiner explain why there would be a serious burden on the examiner if restriction is not required.

The Office Action fails to expressly provide or suggest a serious administrative burden. Because the alleged species are related and drawn to one inventive concept, namely an inventory control method, the classification, subject matter and field of search should be the same.

For these reasons, Applicant respectfully requests withdrawal of the Election of Species Requirement. A speedy and favorable Office Action on the Merits is respectfully solicited.

If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned at 215-599-0600.

Respectfully submitted,

/JLK/

John L. Knoble  
Registration No. 32,387

Date: October 5, 2006

KNOBLE YOSHIDA & DUNLEAVY, LLC  
Eight Penn Center- Suite 1350  
1628 John F. Kennedy Boulevard  
Philadelphia, PA 19103  
(215) 599-0600

Application Serial No.: 10/085,394

Response dated: October 5, 2006

Reply to Office Action of: September 6, 2006

Page 4 of 4